

Claims 1 and 3-29 are now pending the above-referenced patent application. No claims have been deleted, added or amended.

The Examiner has rejected claims 1, 3-7, 11-17, 19-27 and 29 under 35 U.S.C 103(a), and has relied on arguments presented in the previous Office Action. The rejection of these claims by the Examiner is respectfully traversed.

It is well-established that in order to establish a prima facie case of obviousness, the Examiner must first show a suggestion or motivation to modify the prior art or to combine two or more references. Additionally, there must be a reasonable expectation of success in combining or modifying the reference(s). Finally, the prior art reference(s) must teach or suggest all the claim limitations. It is respectfully asserted that the Examiner has failed to show a suggestion or motivation to combine Fan and Go. Fan relates to a method for improving the appearance of a decoded image by using various local post processing techniques. There is no contemplation of preprocessing an image or to transmitting an image in Go, and Go appears to relate to interpreting a decoded image, rather than disassembling and reassembling an image as expressed in Fan. There does not appear to be any teaching or suggestion found within Fan or Go to combine these two references. What the Examiner has appeared to do is perform "hindsight construction", which the Federal Circuit has made clear is not appropriate. As stated in *In Re Rouffet*, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998):

[A]n examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention...

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show motivation to combine the references that create the case for obviousness.

Here, the Examiner has failed to provide the required suggestion or motivation to make the asserted combination.

However, assuming only for the sake of legal argument that there is a suggestion or motivation to combine Fan and Go, there still would be elements of the claimed subject matter not met by the combination.

As just one example, the edge detection methods disclosed by Fan and Go, as compared to the claimed subject matter, are materially different. Go discloses a sum of differences approach, as stated on col. 6, line 66 to col. 7, line 23. This method disclosed by Go is applied to both the horizontal and vertical directions individually. Conversely, the detailed description, page 7, line 14 to page 8, line 15, disclose multiple methods for edge detection that may be used in accordance with the claimed subject matter, none of which are the same as the Go approach. It is respectfully asserted that Fan and Go disclose different solutions to a similar problem, and the differences are patentably distinct.

According to the Examiner, "Applicant argues features of the invention described on pages 7-8 of the specification but which are not specifically claimed. The edge detection method claimed broadly reads on the approach taken by Go." As stated previously, the claimed subject matter discloses at least one edge detection method that is not disclosed by Go, and, therefore, there are claimed elements not disclosed by Go. It is, therefore, respectfully asserted that the combination of Fan and Go, while improper, would still not meet all the elements of the claimed subject matter.

Claims 3-5 depend from and include all limitations of claim 1. It is respectfully asserted that claims 3-5 are in a condition for allowance for the same reasons as claim 1.

Claims 6-7, 11-17, 19-27, and 29 patentably distinguish from the cited patents for reasons similar to claim 1. It is, therefore, respectfully asserted that these claims are in a condition for allowance.

The Examiner has rejected claims 8-10, 18, and 28 under 35 U.S.C 103(a) as being unpatentable over Fan and Go, as applied to claims 6, 17, and 27, and further in view of Chamzas. The rejection of these claims is respectfully traversed.

It is conceded by the Examiner that the combination of Fan and Go discloses a method of transmission where the image data and edge detection data is multiplexed prior to transmission. Conversely, Applicants claimed subject matter discloses one possible embodiment where the data is transmitted separately. Quoting from the detailed description, page 10, lines 6-12, "Although the invention is not limited in this respect, it is envisioned that an edge detection map may be transmitted as supplemental signal information corresponding to a coded video frame. Therefore, at the far or

receiving end of the communications channel, depending on the capabilities of the decoder, this edge detection map may or may not be employed to enhance the decoded video frame, as described in more detail in the embodiment below. Likewise, in addition to transmitting one edge detection map, in alternative embodiments, multiple edge detection maps may be transmitted, as previously indicated.”

It is respectfully asserted that Chamzas is nonanalogous prior art, and the Examiner has again performed “hindsight construction” in making this rejection. As stated in *Shatterproof Glass Corp. v. Libbey-Owens Ford*, 758 F.2d 613, 225 USPQ 634 (Fed. Cir. 1985), “...in determining whether references are within the pertinent art, [the jury] should look to the nature of the problem confronting the inventor and should consider whether the field of reference is reasonably pertinent to that problem.” Additionally, as stated in *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986), “Under the two-step test for determining whether a prior art reference is nonanalogous and thus not relevant in determining obviousness, it must be determined (1) whether the reference is “within the field of the inventors endeavor,” and (2) if not, whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.”

It is respectfully asserted that these principles apply here. Using the factual inquiry as stated above, it is self-evident that the Chamzas patent is not within the field of endeavor, and, therefore, fails prong (1) of the analysis. The Chamzas patent relates to progressive transmission of two-tone facsimile images, while the claimed subject matter relates generally to video coding and/or decoding. Continuing the analysis as stated above, it is also evident that the Chamzas patent is not reasonably pertinent to the particular problem with which the inventor was involved, and, therefore, fails prong (2) of the analysis. Therefore, it is respectfully asserted that the Chamzas patent is not relevant in determining obviousness, and the rejection, therefore, is improper.

The aforementioned test was applied in *Wang Laboratories v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993), and involved memory circuits, each patent disclosing single in line memory modules disclosing 9 storage chips. The Court stated, “[T]he jury could reasonably have found that the first criterion of the analogous art test has not been met and the prior art and the claimed subject matter are not in the same field of endeavor.” “The Allen-Bradley art is not in the same field of

endeavor as the claimed subject matter merely because it relates to memories." "There is substantial evidence in the record to support a finding that the Allen-Bradley prior art is not reasonably pertinent [because] size was not a consideration in the ...work."

It is respectfully asserted that the same principle applies here. Merely because both the Chamzas patent and the claimed subject matter apply to transmitting data, this does not automatically make them analogous art. It is, therefore, respectfully asserted that claims 8-10, 18 and 28 are in a condition for allowance.

### CONCLUSION

In view of the foregoing, it is respectfully asserted that all claims pending in this application, as amended, are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 264-9427. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Respectfully submitted,



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